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|--|-------------|----------------------|---------------------------------|-----------------------------|
| 10/798,570   | 03/12/2004  | Kazuhiko Nakaya      | 248080US2                       | 6514                        |
| 22850  | 7590        | 09/27/2007           |                                 |                             |
| OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                      | EXAMINER<br>LEE, CHEUKFAN       |                             |
|  |             |                      | ART UNIT<br>2625                | PAPER NUMBER                |
|  |             |                      | NOTIFICATION DATE<br>09/27/2007 | DELIVERY MODE<br>ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

**Application No.**

10/798,570

**Applicant(s)**

NAKAYA, KAZUHIKO

**Examiner**

Cheukfan Lee

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-11, 13-18, 20 and 21 is/are rejected.
- 7) ☒ Claim(s) 5, 12 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 6/14/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: See Continuation Sheet.

Continuation of Attachment(s) 6). Other: List of related cases, initialed by Examiner.

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1. Claims 1-21 are pending. Claims 1, 8 and 15 are independent.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 8 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Sata et al. (Japanese Patent Application Publication No. 3-52377). A machine translation to English is not available at the time of this Office action.

Regarding claim 1, Sata et al. discloses an image reading apparatus (Fig. 9) comprising a reader (including 11-13) configured to read one side of an original document being conveyed at a reading position (see dotted line at lens 12 in Fig. 9), a contact glass (17) comprising a surface (the lower surface of class 17) configured to contact the original document, a reference (shading correction reference face W) disposed at a side of the contact glass (17) (the upper side of 17 as viewed in Fig. 9) opposite to the surface (the lower surface of 17) and configured to be movable between the reading position and a standby position (the position of the reference W as shown in Fig. 9), the reference (W) comprising a surface (W) configured to face the reader (the reader including 11-13), the surface (W) having a predetermined color to provide shading data used for a shading correction, and a carrier (inherent) configured to move the reference (W) to the reading position (see double-headed arrow in Fig. 9), wherein

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the reader (including 11-13) is configured to obtain the shading data by reading the predetermined color on the surface (W) of the reference (W) at the reading position.

Claim 8 is rejected for the reason given for claim 1.

Claim 15 is rejected as being a method claim corresponding to rejected apparatus claims 1 and 8.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 3, 4, 9, 10, 11, 16, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sata et al. (JP Patent Application Publication No. 3-52377) in view of Applicant's admitted prior art.

Regarding claims 2 and 3, Sata et al. discussed above for claim 1 does not seem to disclose that the reader (including 11-13 in Fig. 9) is configured to read the predetermined color on the surface (W) of the reference (W) at a plurality of locations to obtain data and a calculator configured to average the data to obtain the shading data. However, the claimed features of generating shading data to avoid problems that occur

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due to undesired substances caused by gas of a lamp or motion of scanning member in an apparatus are not novel as discussed by Applicant in the prior art discussion (page 2, lines 13-20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the concept of Applicant's prior art to read the reference (W) at a plurality of locations to obtain data and provide Sata et al. with a calculator to average the data to obtain the shading data in order to avoid the problems stated above.

Regarding claim 4, although Sata et al. does not disclose that the reader's sequentially reading the predetermined color on the surface (W) of the reference (W) at the plurality of locations is according to a motion of the reference (W), based on the discussion of claim 2, one of ordinary skill in the art would have realized that relative motion between the reference surface (W) and the reader (including 11-13) is caused by moving the glass plate (17) on which the reference surface (W) is positioned. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made that reading of the surface (W) at a plurality of locations is according to the motion of the reference instead of a motion of the reader.

Claims 9, 10 and 11 are rejected for the reasons given for claims 2, 3 and 4, respectively.

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Claims 16, 17 and 18 are rejected as being method claims corresponding to apparatus claims 2, 3 and 4 respectively.

6. Claims 6, 13 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sata et al. (JP Patent Application Publication No. 3-52377) in view of well known art.

Regarding claim 6, the reference (W) is a reference face (see abstract), which is interpreted to mean a reference sheet having a surface. Sata et al. does not seem to disclose a transparent member covering the surface of the reference sheet configured to face the reader. However, the examiner took Official Notice of the fact that employing a transparent member as a protective layer to protect a shading reference layer or sheet from undesired substances is a well known concept. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the well known concept to employ a transparent member to cover the reference sheet (i.e., the transparent member placed on the upper surface of W as viewed in Fig. 9) in order to protect the reference sheet.

Claim 13 is rejected for the reason given for claim 6.

Claim 20 is rejected as being a method claim corresponding to rejected apparatus claims 6 and 13.

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7. Claims 7, 14 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sata et al. (JP Patent Application Publication No. 3-52377) in view of well known art as applied to claims 6, 13 and 20 above, and further in view of Yamada (U.S. Patent No. 5,812,172).

Regarding claim 7, Sata et al. in view of well known art discussed above for claim 6 does not comprise a cleaner as claimed.

Yamada discloses an image reading apparatus comprising a cleaner (30 in Figs. 2A and 7A) disposed at the standby position (home position) of the image sensor (24). When the image sensor (24) is moved back to or at the standby position (home position), the cleaner (30) makes contact with or closely confronts the transparent member (the image pickup surface 24a) of the image sensor (24) (col. 3, lines 45-53, col. 5, lines 40-48). Yamada teaches the concept cleaning a transparent member of a movable member using a cleaner disposed at a standby position of the movable member as the movable member moves to the standby position, removing dirt, dust particles and the like adhere on the transparent member (24a). Therefore, based on the discussion for claim 6 that the reference sheet (W) is covered with the transparent member facing the image reader (including 11-13 of Fig. 9 of Sata et al.), using the concept of Yamada to employ a cleaner at the standby position of the reference (W) having the transparent member covering the reference surface (W), such that the cleaner is disposed between the transparent member and the reader and contacts the transparent member and cleans a surface of the transparent member facing the reader (including 11-13 of Fig. 9 of Sata et al.) as the reference (W) moves between the

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reading position and the standby position, would have been obvious to one of ordinary skill in the art.

Claim 14 is rejected for the reason given for claim 7.

Claim 21 is rejected as being a method claim corresponding to apparatus claims 7 and 14.

8. Claims 5, 12 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is an examiner's statement of reasons for allowance:

Claims 5, 12 and 19 would be allowable over Sata et al. (JP 3-52377) because the standby position of the reference (W) of Sata et al. (as shown in Fig. 9) is not above the reading position but at substantially the same level as the reading position, and Sata et al. does not disclose that the reference (W) slides down towards the standby position from the reading position when the carrier is deactivated.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

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accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Hata Toshihiro (Japanese Application Publication No. 61-290858), "Original moving type reader", white reference member (7) movable between a reading position (Fig. 1) and a standby position (Fig. 2)

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee whose telephone number is (571) 272-7407. The examiner can normally be reached on 9:30 a.m. to 6:00 p.m., Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Cheukfan Lee  
September 15, 2007